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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@hittgaines.com

Office Action Summary

Application No.

09/747,937

Applicant(s)

CURTIN, STEVEN D.

Examiner

HELEN SHIBRU

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4, 8, 10, 12, 13, 15, 17, 19, 20 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6, 7, 9, 11, 14, 16, 18, and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendments, filed 10/09/2009, have been entered and made of record. Claims 1-22 are pending, claims 2, 4, 8, 10, 12, 13, 15, 17, 19, 20, and 22 are withdrawn from consideration.

Response to Arguments

2. Applicant's arguments filed 10/09/2009 have been fully considered but they are not persuasive. See the response sets forth below.

Applicant states on page 3, "There is no teaching that Go selects the first (or last for that matter) blank portion of the recorded medium to record the new information." Then in the same paragraph Applicant states, " the principle of operation of Go is to scan an entire recording medium, detect control pulses that mark used portions of the recording medium, select a portion of the recording medium where no control pulses were detected, and position a recording head at the selected portion of recording medium to record new information. "

In response the Examiner would like to direct Applicant's attention to the two statements above. Applicant agrees that the cited reference of Go teaches detecting the control pulses and select a portion of the recording medium where no control pulses were detected. Portion of the recording medium where there is no control pulse located is selected to record the new information. Contrary to the first statement, Go teaches, as Applicant agrees on the second statement, Go selects the first (or last for that matter) blank portion of the recorded medium to record the new information. The portion can be first or single portion of the recording medium but there is a portion in the recording medium of Go where new information is recorded.

In response to Appellant argument, "the cited portions of the cited combination of Go and Nagasawa do not provide *prima facie* case of obviousness for independent claim 1," the Examiner respectfully disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Go teaches a method for recording and protecting information recorded on a recording medium. Similarly Nagasawa teaches a recording medium with circuit for detecting the remaining amount of available space. The Examiner provided articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Applicant states, "Kurihara does not teach or suggest the limitation of deactivating a record circuit as detection of a pre-existing signal occurs as recited in pending independent claims 9 and 16."

In response the Examiner respectfully disagrees. On page 5 of the Office Action, mailed on 07/09/2009, the Examiner states the combination of Kurihara, GO, and Nagasawa, and page 7 states the combination of Kurihara, Official Notice, and Nagasawa. In addition, as stated on the Office Action, the two claims, claim 1 and 9, recites the present invention using particular ways. Furthermore Kurihara teaches deactivating a record circuit as detection of a pre-existing signal occurs. See again the CPU that performs the process shown in figure 6 which includes S1-6 where Kurihara discloses detecting a signal recorded on the tape to determine if the tape is blank or not, and deactivating a record circuit in the said cassette player (see figure 2, figure 6, S1-06

and S1-13, when the tape is not blank, the data is not recorded at the selected position, Note also that S1-6 and then S1-7 to S1-12 is not processed (not activated) if the tape is not a blank tape, i.e. S17-S1-12 is deactivated).

Therefore the claimed invention does in fact read on the cited references for at least the reasons discussed above and as stated in the detail Office Action as follows.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5, and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Go (US Pat. No. 5, 936, 786) in view of Nagasawa (US Pat. No. 5,877,906).

Regarding claim 1, Go discloses an electronic write protect apparatus for storage media (see figure 3) comprising:

at least one record element for writing information to a given magnetic storage media (see claim 1 where it teaches a recording means for writing information on recording medium, tape);

a pre-existing electronic information signal detection element to read a pre-existing electronic information signal stored on said given magnetic storage media (see claims 1 and 2 where Go recites signal detecting means for detecting the presence or absence of a control pulse from a recording medium),

a record deactivation circuit to prevent recording on said given magnetic storage media when said pre-existing electronic information signal detection element detects said pre-existing electronic information signal stored on said given magnetic storage media (see abstract, col. 1 line 53-67, col. 2 line 16-col. 3 line 39, claims 1-6, recording is only performed when the control pulse is not detected by the signal detecting means, and if control pulse is detected recording is deactivated to prevent unintentional erasure of the information recorded on the recording medium).

claim 1 differs from Go in that the claim further requires the said deactivation occurring at or about a time of occurrence of said detection of said pre-existing signal.

In the same field of endeavor Nagasawa teaches deactivating recording operation at or about a time of detecting pre-existing information signal (see figure 11 steps 306, 310 and 311 where the prior art teaches deactivating a recording operation when the remaining amount of the video tape of the video tape cassette is the set value X or greater, see also col. 13 lines 20-26 and col. 14 lines 1-13). See also figure 13 steps 362-363, figure 14 steps 405, 407 and 410, figure 15 steps 505, 507 and 508. Therefore in light of the teaching in Nagasawa it would have been obvious to one of ordinary skill at the time the invention was made to modify Go by providing a deactivating operation at a time of detecting a pre-existing or pre-set signal in order to avoid loss of data.

Regarding claim 3, Go discloses at least one record element is attached to a spinning element (see figures 1 and 3, video tape is attached to a spinning element).

Regarding claim 5, Go discloses pre-existing electronic signal detection element is attached to said spinning element (see claims 1 and 2 where Go recites signal detecting means

for detecting the presence or absence of a control pulse from a recording medium wherein the recording medium is attached to a spinning element).

Regarding claim 6, Go discloses the said given magnetic storage media is a video tape (figure 1, col. 1 lines 16-30, and col. 2 lines 18-23).

Regarding claim 7, Nagasawa discloses magnetic tape storing digital information (see col. 3 lines 53-65, col. 18 lines 23-31 and lines 38-46).

5. Claims 1, 3, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurihara et al. (US Pat. No. 6,442,108) in view of Go (US Pat. No. 5, 936, 786) and further in view of Nagasawa (US Pat. No. 5, 877, 906).

Regarding claim 1, Kurihara discloses an electronic write protect apparatus for storage media (see figure 2) comprising:

at least one record element for writing information to a given magnetic storage media (see figure 2, recording and tape 15);

a pre-existing electronic information signal detection element (the CPU performs the process shown in figure 6 which includes S1-6) to read a pre-existing electronic information signal (the pre-existing electronic signal is previously recorded data, audio, song title, or count) stored on said given magnetic storage media (see figure 6, CPU determine if the tape is blank or not, i.e. CPU determines whether or not previously recorded audio data (pre existing signal) can be found in the tape),

Claim 1 differs from Kurihara in that the claim further requires a record deactivation circuit to prevent recording on said given magnetic storage media when said pre-existing

electronic information signal detection element detects said pre-existing electronic information signal stored on said given magnetic storage media.

In the same field of endeavor Go discloses a record deactivation circuit to prevent recording on said given magnetic storage media when said pre-existing electronic information signal detection element detects said pre-existing electronic information signal stored on said given magnetic storage media (see abstract, col. 1 line 53-67, col. 2 line 16-col. 3 line 39, claims 1-6, recording is only performed when the control pulse is not detected by the signal detecting means, and if control pulse is detected recording is deactivated to prevent unintentional erasure of the information recorded on the recording medium by confirming that the portion on which the information is recorded is a blank portion and recording new information on the blank portion). Therefore in light of the teaching in Go it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kurihara by including an activation and deactivation circuit in order to prevent essential recorded information from being erased.

Claim 1 further differs from the above combination in that the claim further requires the said deactivation occurring at or about a time of occurrence of said detection of said pre-existing signal.

In the same field of endeavor Nagasawa teaches deactivating recording operation at or about a time of detecting pre-existing information signal (see figure 11 steps 306, 310 and 311 where the prior art teaches deactivating a recording operation when the remaining amount of the video tape of the video tape cassette is the set value X or greater, see also col. 13 lines 20-26 and col. 14 lines 1-13). See also figure 13 steps 362-363, figure 14 steps 405, 407 and 410, figure 15 steps 505, 507 and 508. Therefore in light of the teaching in Nagasawa it would have been

obvious to one of ordinary skill at the time the invention was made to modify the above proposed combination by providing a deactivating operation at a time of detecting a pre-existing or pre-set signal in order to avoid loss of data.

Regarding claim 3, Kurihara discloses at least one record element is attached to a spinning element (see figure 2, components 15, 27, 29 and 30).

Regarding claim 5, Kurihara discloses pre-existing electronic information signal detection element is attached to said spinning element (see figure 2, components 15, 26, and 27).

Regarding claim 6, Kurihara discloses the said given magnetic storage media is a video tape (see figure 2 and col. 3 lines 34-39, and see also Go et al. figure 1 and col. 1 lines 16-30).

Regarding claim 7, Kurihara discloses storage media stores digital information (see col. 4 lines 37-40). See also Nagasawa's col. 3 lines 53-65, col. 18 lines 23-31 and lines 38-46.

6. Claims 9, 11, 14, 16, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurihara et al. (US Pat. No. 6,442,108) in view of Official Notice and further in view of Nagasawa (US Pat. No. 5, 877, 906).

Regarding claim 9, Kurihara discloses an electronic write protect method for storage media comprising: attempting to record information on a given tape placed in a cassette player (see figure 6); detecting a pre-existing signal from the said given tape (the CPU performs the process shown in figure 6 which includes S1-6 where Kurihara discloses detecting a signal recorded on the tape to determine if the tape is blank or not); and deactivating a record circuit in the said cassette player (see figure 2, figure 6, S1-06 and S1-13, when the tape is not blank, the data is not recorded at the selected position, Note also that S1-6 and then S1-7 to S1-12 is not processed (not activated) if the tape is not a blank tape, i.e. S17-S1-12 is deactivated).

Claim 9 differs from Kurihara in that the claim further requires the pre-existing signal is a video signal. Although Kurihara does not specifically disclose the tape records/recorded video data, Kurihara discloses an audio data recorded on the tape. Official Notice is taken that it is well known in the art at the time the invention was made to record video signal in tape. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kurihara by adding a video signal in the tape in order to record moving image data.

Claim 9 further differs from the above combination in that the claim further requires the said deactivating performs at or about a time of occurrence of said detection of said pre-existing signal.

In the same field of endeavor Nagasawa teaches deactivating recording operation at or about a time of detecting pre-existing information signal (see figure 11 steps 306, 310 and 311 where the prior art teaches deactivating a recording operation when the remaining amount of the video tape of the video tape cassette is the set value X or greater, see also col. 13 lines 20-26 and col. 14 lines 1-13). See also figure 13 steps 362-363, figure 14 steps 405, 407 and 410, figure 15 steps 505, 507 and 508. Therefore in light of the teaching in Nagasawa it would have been obvious to one of ordinary skill at the time the invention was made to modify the above proposed combination by providing a deactivating operation at a time of detecting a pre-existing or pre-set signal in order to avoid loss of data.

Regarding claims 11 and 18, Kurihara discloses attempting to record information is performed by a spinning element (see figure 2, components 15, 27, 29 and 30).

Regarding claims 14 and 21, Kurihara discloses the said video tape stores digital information in magnetic form (see col. 4 lines 37-40).

Regarding claim 16, the limitation of claim 16 can be found in claim 9 above. Therefore claim 16 is analyzed and rejected for the same reasons as discussed in claim 9.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/
Examiner, Art Unit 2621
December 30, 2009

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621